

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	David Kirchhoff, <i>et al.</i>
Application No. 10/797,284	Filing Date: March 10, 2004
Title of Application:	Weight Control System With Meal Plan And Journal
Confirmation No. 2939	Art Unit: 2185
Examiner	Heidi Riviere

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Reply Brief Under 37 CFR §41.41

Dear Sir:

Having received the Examiner's Answer, Appellant submits this Reply Brief for the above-captioned application pursuant to 37 C.F.R. §41.41 as follows.

Most of the arguments presented in the Examiner's Answer were presented during prosecution, and thus, have already been dealt with in Appellant's Appeal Brief. Appellant submits this Reply to briefly elaborate on issues raised in the Examiner's Answer.

Argument

Claims 1, 7, 36, 48-49, 69 and 74

The examiner has submitted that "Mault-164 teaches, 'Failure to reach weight goals may be used to modify food orders placed by the PDA' (paragraph 98)." The examiner then goes on to state that it "is inherent within this reference that the only way to know that weight goals have not been met is to have updated weight information" and that the "introduction of new weight information will inform the system that the food order has to be changed to reflect the change in the user's weight." (Examiner's Answer, p. 24).

Appellant objects that for the first time the examiner is now bringing up the issue of inherency, apparently now admitting that Mault-164 does not explicitly disclose a "meal plan being automatically altered by the processor based on the updated body weight", but that somehow, the disclosure must be there.

In support of the inherency argument, the examiner concludes that the user must provide updated weight information to the system so that the system adjusts a shopping list. This is not true. For example, the system could prompt the user to indicate whether or not a weight goal had been achieved and the user could indicate either that they did or they did not. While the examiner seeks to alter the claim language to broadly read receiving weight information, claim 1, for example, recites "receive an updated weight of the person." The system in Mault-164 does not have to "receive an updated weight of the person" to adjust a shopping list. The entire premise of an inherency argument is that the limitation is "necessarily present" as there is no other way the system could function. *Cont'l Can Co. v. Monsanto Co.*, 948 F.2d 1264 (Fed. Cir. 1991). However, the system in Mault-164 does not necessarily have to "receive an updated weight of the person" to adjust a shopping list as stated above.

Another issue that is glossed over is the fact that claim 1 recites “a meal plan” and adjustment of the meal plan based on receiving an updated weight of the individual. On the other hand, section of Mault-164 that the examiner points to as modifying food orders based on failure to reach weight goals is limited to the generation of “shopping lists” not to a particular “meal plan.” In other words, the system in Mault-164 will take many things into consideration in the generation of the list of food a user should purchase at the supermarket, one of those things being whether a user has reached a weight goal, and based on that information, the system in Mault-164 may adjust a weekly shopping list. However, claim 1 is directed toward a system that will adjust individual meals providing precise controls to the individual based on an updated weight of the individual. While it is true that direction relating to individual meals is addressed in Mault-164, this is only by means of live personnel providing feedback to a user relating to a particular meal. (Para. 74) Accordingly, Appellant respectfully submits that modifying a weekly shopping list is not the same as modifying a particular meal plan. In fact, Mault-164 differentiates between the shopping list and a particular meal, but never states that a meal is adjusted based on an updated weight of a user. (Para. 57 & 98).

Claims 22 and 74

The examiner has further submitted that claim 22 “can be considered non-functional descriptive data” and “claim 74 merely claims information and which is non-functional descriptive data.” (Examiner’s Answer, pp. 26-27). The examiner also states that “this data adds little, if anything, to the claimed acts or steps and thus do not serve as limitations on the claims.”

Claims 22 recites “wherein the demographical information includes at least one of the following: gender, race, and ethnicity.” Claim 74 recites “wherein the input/output device is further operable to receive an updated body weight from the person, and wherein the meal plan is automatically altered by the processor based on the updated body weight.”

Claim 22 ultimately depends from claim 7. Claim 7 is a method claim that includes the steps of “receiving an updated weight of the person” while claim 22 recites various demographical information that is also received by the system. While it is true that data in and of itself is not functional, claim 22 is a method claim that adds the step of receiving particular information that can be used by the system. For example, a person’s gender, race and ethnicity may have a bearing on how fast a person burns calories and therefore can be taken into consideration when suggesting a particular meal. This information allows the system to be further customized to the user.

Claim 74 depends from claim 73 and provides for specific functionality of the input/output device, namely that it is “operable to receive an updated body weight” and provides the additional functionality that “the meal plan is automatically altered . . . based on the updated body weight.” Appellant does not see how the specifically recited functionality of automatic altering of the meal plan based on the updated weight can be characterized as “non-functional descriptive data.” The functionality is specifically claimed.

Claim 73

Appellant noted that the examiner had combined the teachings of Mault-164 with Mault-069 and the only reason given to combine these references was that “Mault-069 provides diet information in the form of caloric intake and meal information” and “[t]his information can be displayed on the basis of a day or a week.” (Official Action 2/25/08, p. 21). Appellant then submitted that obviousness requires a suggestion of all the elements in a claim (*CFMT, Inc. v. Yieldup Int’l Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003)) and “a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741, 82 USPQ2d 1385 (2007). Here, we find that the Examiner has not provided a reason that would have prompted the skilled worker to have arranged them in the manner necessary to reach the claimed invention, but in-

stead simply stated that they could have been combined. It is incumbent upon the Examiner to establish the factual basis to support the legal conclusion of obviousness. See *In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). It does not matter how strong the Examiner's convictions are that the claimed invention would have been obvious, or whether we might have an intuitive belief that the claimed invention would have been obvious within the meaning of 35 U.S.C. § 103 as neither circumstance is a substitute for evidence lacking on the record. The examiner then states that "[i]f Applicant claims a journal system it would be obvious that this system is portable" and that "Mault-164 provides a portable weight management system that enable a client to manage their weight throughout the day." (Examiner's Answer, pp. 27-28).

These statements are confusing and don't appear to provide any motivation for combination of Mault-164 with Mault-069. The statement relating to "[i]f Applicant claims a journal system" has no relation on claim 73. It's clear what claim 73 claims, which is a "system for facilitating the control of body weight of a person." The issue of portability is never mentioned in claim 73.

It is the Examiner's burden to establish prima facie obviousness. See *In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993). As stated above, obviousness requires "a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741, 82 USPQ2d 1385 (2007). Without an articulated reason to combine the element in the way the claimed new invention does, there can be no prima facie obviousness. The examiner has failed to provide this reason to combine and there the examiner's rejection under 103 is improper.

Claims 17 and 51

The examiner has listed claims 17 and 51 under a separate topic "**Issues 3 and 4: Claims 17 and 51.**" (Examiner's Answer, p. 28). However, upon review of the ex-

aminer's arguments under this section, the examiner does not appear to ever address either claim 17 or claim 51. Rather, the examiner provides duplicate arguments as those presented in connection with claims 1, 7, 36, 48-49, 69 and 74 and the arguments on pages 28-30 are a duplicate to those extending from pages 24-27. In fact, under this section, the examiner refers to claims 10-13 and 22 (p. 29), but never refers to claims 17 or 51. Appellant does not know if this is a clerical error. However, for completeness, Appellant submits that it is impossible to address any potential issues with respect to claims 17 or 51 without an articulated argument presented by the examiner.

Conclusion

For the foregoing reasons, Applicant respectfully submits that the claimed invention embodied in each of claims 1-59 and 69-80 is patentable over the cited prior art. As such, Appellant respectfully requests that the rejections of each of claims 1-59 and 69-80 be reversed and the Examiner be directed to issue a Notice of Allowance allowing each of claims 1-59 and 69-80.

Respectfully submitted,

December 4, 2009

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